

Applicant: Orhomuru, Sunday

Atty. Docket No. 06-0713-SOR.RA

Appl. No. 09/862,789

Filed: September 21, 2001

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Orhomuru, Sunday

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Docket:

06-0713-SOR.RA

)

Serial No.: 09/862,789

)

Examiner:

Jacobs, Lashonda T.

)

Filed: September 21, 2001

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Group Art Unit:

2157

)

For:

**DATA TRANSFER OR TRANSFER OF DATA USING WIRELESS  
MOBILE PHONE AND ANY OTHER WIRELESS MOBILE DEVICES**

Dated: January 21, 2008

Filed via EFS-Web

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REQUEST FOR PRE-APPEAL BRIEF PANEL REVIEW CONFERENCE WITH  
REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R. §1.136(a)**

Sir:

Responsive to the Final Office Action of September 20, 2007 and subsequent Advisory Action mailed December 20, 2007, in the above-styled patent application, please consider the following argument in accordance with the Pre-Appeal Brief Conference Pilot Program. A Notice of Appeal with filing fee of \$255.00 is enclosed herewith, along with the Pre-Appeal Brief Request for Review form, and Applicant respectfully submits that the application is in condition for allowance. There are no amendments to the claims.

Also enclosed, please find a petition for a one-month extension of time to respond pursuant to 37 C.F.R. §1.136(a), and a check in the amount of \$60.00 pursuant to 37 C.F.R. §1.17(a)(1).

### ARGUMENT

I. The examiner has failed to establish a prima facie case of obviousness of independent claims 1 and 2 under 35 U.S.C. §103(a) over Christensen (U.S. Pat. No. 6,662,193) in view of Hofmann et al. (U.S. Pat. Appl. No. 2001/0020255).

"If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Further, all of the limitations of Applicant's invention must be present in the combination. See generally, General Am. Transp. Co v. Cryo-Trans, Inc., 93 F.3d 766 (Fed. Cir. 1996), *cert. denied*, 117 S. Ct. 1334 (1997); Wiener v. NEC Electronics, Inc., 102 F.3d 534 (Fed. Cir. 1996).

Here, the Examiner has not established any teaching in the references of record of the element of a mobile phone comprising a browser as is required by Applicant's Independent claims 1 and 2.

Thus, the prior art references, even if combined would not be equivalent in structure or function to the claimed invention and thus cannot support an obviousness rejection. Accordingly, the Examiner has not established a prima facie case of obviousness, and claims 1 and 2 should be allowed.

A. Even if all the elements were present, which they are not, there would not be obviousness.

"[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (U.S. 2007).

"Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741

(U.S. 2007). Applicant respectfully submits that the Examiner has made mere conclusory statements and has not articulated reasoning with a rational underpinning to support obviousness.

"A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See Graham, 383 U.S., at 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 412 (CA6 1964)))." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1742-1743 (U.S. 2007). It appears to Applicant that the Examiner must have utilized impermissible hindsight to draw her conclusions based on the combination cited. Otherwise, to assert that PDA scanners and personal computer browsers equate to mobile phone browsers would not follow.

B. *The Hoffman et al. '255 reference teaches away from the combination formed by the Examiner.*

"If the prior art teach away from combining known elements in the manner claimed by the invention at issue, discovering a successful way to combine them is less likely to be obvious. See KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727 at 1740, 1745 (2007)." Astrazeneca AB v. Mylan Labs., Inc. (In re Omeprazole Patent Litig.), 490 F. Supp. 2d 381, 516 (D.N.Y. 2007).

Specifically, in paragraph [0035] of Hoffman et al. (U.S. Pat. Appl. No. 2001/0020255) cited by the Examiner, Hoffman et al. '255 teaches that "[b]ecause of the limited capabilities of devices 102B [mobile phone] and 102E [PDA], functionality is not as extensive as from a system that can run a full browser." [Edits in brackets.] Thus, clearly, WAP devices such as mobile phones and PDAs as known heretofore were not capable or envisioned as being capable of running a browser. Thus, Hofmann et al. '255 teaches away from Applicant's invention and it is improper to combine Hoffman et al. '255 with other references.

Even more particularly, according to Hoffman et al. '255, paragraph [0029], "a user can access and use applications or services, e.g., application 112 in a suite of applications 120, on server computer system 100 from almost any available device, e.g., any one of a portable computer 102A, a mobile telephone 102B, a workstation 102C, a home personal computer (PC) 102D, a personal digital assistant 102E, or an Internet cafe machine 102F. No longer is a user limited to using either workstations and/or portable computers with suite of applications 120 installed thereon." Thus, the mobile phone or other device can only run applications on another computer to manipulate data and clearly lacks any ability to run its own applications to interface with a computer, without the need for applications on the computer. Accordingly, because Hofmann et al. '255 teaches away, the combination Christensen '193 and Hofmann et al. '255 is improper. Accordingly, claims 1 and 2 should be allowed.

II. The Examiner has incorrectly construed Covington et al. (U.S. Pat. Appl. No. 2003/0154135) to have a mobile phone browser.

Paragraph [0012] of Covington '135 describes an in-house or in-mall computer with scanners, not a wireless web browser; in paragraph [0076] of Covington '135 it is clear that the device of Covington '135 is a scanner, not a browser; and in paragraph [0101], Covington '135 discloses browsing done by computer, not by a handheld. Further, because Covington et al. '135 does not disclose that the handheld device has a browser, rather that the computer has a browser, the Examiner's rejection of claim 3 and 4 is improper. Accordingly, claims 3 and 4 should be allowed.

Covington '135 solves its problem completely and there is no need for a mobile phone browser. Such a mobile phone browser would not be utilized to read barcodes in a retail store, and with the online ordering via computers 28 and 34, there is no need for a mobile phone. Accordingly, lacking any teaching, suggestion or motivation, there is no reason to combine Covington '135 with any other reference.

Covington '135 is nothing more than a system of ordering products online from a computer or by carrying around a PDA that scans barcodes or on which product numbers or products found on a store shelf are entered. In Covington '135, there are PDA scanners that are carried around a store to scan barcodes of products to purchase or into which numbers can be entered to select products to purchase. In particular, the only browsing taught by Covington '135 is via PCs 28 and 32 of Figure 1, which are unrelated in any way with mobile phones.

Applicant's limitation of MOBILE PHONE BROWSERS "cannot be met by any element in the reference that performs a different function". RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440 (Fed. Cir. 1984). Thus, since PDA scanners do not teach mobile phone browsers, the reference does not supply the missing element of a mobile phone browser that is present in Applicant's claims.

Not only are the references lacking in all the elements, but the Covington '135 reference performs in a substantially different way, and, thus, cannot be considered an equivalent of the claimed invention adequate to support an obviousness rejection. See Engel Industries v. The Lockformer Co., 96 F.3d 1398 (Fed. Cir. 1996).

### **CONCLUSION**

No new matter has been added. Applicant respectfully believes that the application is now in condition for allowance and requests that the application proceed to issuance. Should the Panel have any questions regarding this submission, they are invited to contact the undersigned counsel at the telephone number below.

{Signature follows on next page}

Applicant: Orhomuru, Sunday

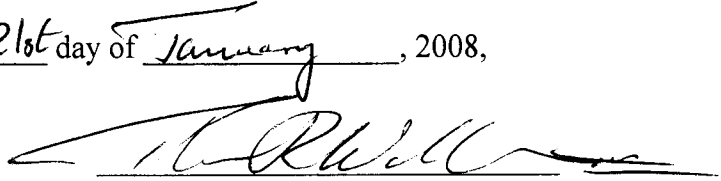
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Respectfully submitted, this 21<sup>st</sup> day of January, 2008,

A handwritten signature in black ink, appearing to read 'T. R. Williamson III', is written over a horizontal line.

Thomas R. Williamson III, Esq.

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